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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,427	01/30/2004	John D. Hicks	1817	6963

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/768,427

Applicant(s)

HICKS, JOHN D.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.


**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

500. 

### DETAILED ACTION

1. Claims 1-8 are pending.

#### *Claim Objections*

2. Claims 3-4 and 6 are objected to because of the following informalities:

In claims 3-4, there should be a comma after "2".

Claim 6 has an improper article at the start of the claim.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8 are rejected under 35 USC 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the seed claimed is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If a seed is not so obtainable or available, a deposit thereof may satisfy the requirements of 35 U.S.C. 112. The specification does not disclose a repeatable process to obtain the exact same seed in each occurrence and it is not apparent if such a seed is readily available to the public. It is noted that Applicant has deposited seeds for 95M80 at the ATCC. If the deposit of these seeds is made under the terms of the Budapest Treaty, then an affidavit or declaration by the Applicant,

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or a statement by an attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. A minimum deposit of 2500 seeds is considered sufficient in the ordinary case to assure availability through the period for which a deposit must be maintained.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit, meets the criteria set forth in 37 CFR 1.801-1.809, Applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that

(a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer;

(d) the viability of the biological material at the time of deposit will be tested (see 37 CFR 1.807); and

(e) the deposit will be replaced if it should ever become inviable.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

Claim 6 is indefinite because many of the members of the Markush group are not tissue types, but rather are cell types or organ types, and hence do not further define "tissue".

Claim 8 is indefinite because it is not clear of the soybean plant that is grown is a plant from the harvested seed or if it is some other soybean plant.

*Claim Rejections - 35 USC §§ 102 - 103*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Tinius (1997, US Patent 5,684,229).

The plants of the instant application, 95M80, and the plants taught by Tinius, 91112039947, have the same traits including seed coat luster (dull), hilum color (imperfect black), pubescence color (gray), flower color (purple), pod color (tan), Maturity group (V), susceptibility to *Phytophthora* race 4, and resistance to soybean cyst nematode race 3, for example. The plants also share similar scores on traits that are affected by environment, *e.g.*, plant height, seed content, lodging score and mean yield. Applicant has also claimed methods of crossing those plants. Methods of crossing 95M80 soybean would be the same as the methods of crossing prior art soybean cultivar 91112039947. Thus, the 95M80 soybean plant and methods of its use, appear to be identical to the 91112039947 plant and methods of its use.

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Alternatively, if the claimed plants and seeds of the instant invention are not identical to 91112039947, then it appears that 91112039947 only differs from the claimed plants and seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur in different progeny of the same cultivar, and wherein said minor morphological variation would not confer a patentable distinction to 95M80 plants. Similarly, the methods of crossing 95M80 soybean would be the same as the methods of crossing prior art soybean cultivar 91112039947. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by 91112039947 soybean plants and methods of their use.

10. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Rhodes (1999, US Patent 5,998,705).

The plants of the instant application, 95M80, and the plants taught by Rhodes, 9392449518696, have the same traits including hilum color (imperfect black), pubescence color (gray), flower color (purple), pod color (tan), Maturity group (V), resistance to soybean cyst nematode race 3, and presence of glyphosate resistance, for example. The plants also share similar scores on traits that are affected by environment, *e.g.*, plant height, seed content, lodging score and mean yield. Applicant has also claimed methods of crossing those plants. Methods of crossing 95M80 soybean would be the same as the methods of crossing prior art soybean cultivar 9392449518696. Thus, the 95M80 soybean plant and methods of its use, appear to be identical to the 9392449518696 plant and methods of its use.

Alternatively, if the claimed plants and seeds of the instant invention are not identical to A9392449518696, then it appears that 9392449518696 only differs from the claimed plants and

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seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur in different progeny of the same cultivar, and wherein said minor morphological variation would not confer a patentable distinction to 95M80 plants. Similarly, the methods of crossing 95M80 soybean would be the same as the methods of crossing prior art soybean cultivar 9392449518696. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by 9392449518696 soybean plants and methods of their use.

11. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Luzzi (2000, US Patent 6,087,562).

The plants of the instant application, 95M80, and the plants taught by Luzzi, 9524879614838, have the same traits including seed coat luster (dull), hilum color (imperfect black), pubescence color (gray), flower color (purple), pod color (tan), Maturity group (V), and presence of glyphosate resistance, for example. The plants also share similar scores on traits that are affected by environment, *e.g.*, relative maturity, plant height, seed content, lodging score and mean yield. Applicant has also claimed methods of crossing those plants. Methods of crossing 95M80 soybean would be the same as the methods of crossing prior art soybean cultivar 9524879614838. Thus, the 95M80 soybean plant and methods of its use, appear to be identical to the 9524879614838 plant and methods of its use.

Alternatively, if the claimed plants and seeds of the instant invention are not identical to 9524879614838, then it appears that 9524879614838 only differs from the claimed plants and seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur in different progeny of the same cultivar, and wherein said minor

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morphological variation would not confer a patentable distinction to 95M80 plants. Similarly, the methods of crossing 95M80 soybean would be the same as the methods of crossing prior art soybean cultivar 9524879614838. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by 9524879614838 soybean plants and methods of their use.

12. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Hicks (2003, US Patent 6,613,966).

The plants of the instant application, 95M80, and the plants taught by Hicks, 95B97, have the same traits including seed coat luster (dull), hilum color (imperfect black), pubescence color (gray), flower color (purple), pod color (tan), Maturity group (V), resistance to stem canker, resistance to soybean cyst nematode race 3, susceptibility to Phytophthora races 4 and 7, and presence of glyphosate resistance, for example. The plants also share similar scores on traits that are affected by environment, *e.g.*, relative maturity, plant height, seed content, lodging score and mean yield. Applicant has also claimed methods of crossing those plants. Methods of crossing 95M80 soybean would be the same as the methods of crossing prior art soybean cultivar 95B97. Thus, the 95M80 soybean plant and methods of its use, appear to be identical to the 95B97 plant and methods of its use.

Alternatively, if the claimed plants and seeds of the instant invention are not identical to 95B97, then it appears that 95B97 only differs from the claimed plants and seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur in different progeny of the same cultivar, and wherein said minor morphological variation would not confer a patentable distinction to 95M80 plants. Similarly, the methods of crossing 95M80



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soybean would be the same as the methods of crossing prior art soybean cultivar 95B97. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by 95B97 soybean plants and methods of their use.

### *Conclusion*

13. No claim is allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

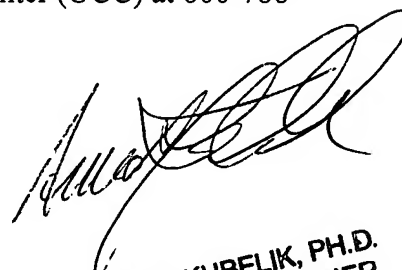
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The central fax number for official correspondence is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne R. Kubelik, Ph.D.  
May 24, 2005



ANNE KUBELIK, PH.D.  
PRIMARY EXAMINER